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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/822,163	03/30/2001	Matthew D. Kraus	YOD-001	6291

26137 7590 10/28/2004

PATENT DEPARTMENT
SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP
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NEW YORK, NY 10036

EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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2121

DATE MAILED: 10/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/822,163

Applicant(s)

KRAUS, MATTHEW D.

Examiner

Donald L. Champagne

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9, 10 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 10 and 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of group B, claims 9-10 and 16-21, in the reply filed on 10 August 2004 is acknowledged.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
3. Claims 9, 10 and 16-21 are rejected under 35 U.S.C. 103(a) as being obvious over Tracy et al.
4. Tracy et al. teaches (independent claims 9, 16 and 21) a system for collecting market data and a method of direct marketing, said system comprising: a data collection device (*terminal 70*, col. 4 lines 2-4) having a first side and a second side, said first side having a *display 72* which displays preprinted questions (col. 14 lines 23-24) and is capable for collecting demographic data, said device having a unique identifier (*a unique IP address*, col. 11 line 49), said data collection device/*terminal 70* also reading on a second computer; and a first computer system (*central host 14*, col. 5 line 50) capable of retrieving information provided in applying for *customer loyalty card 210* (col. 6 lines 3-7 and 57-60), which reads on a database of searchable information including demographic data.
5. Tracy et al. does not teach that said second side of said data collection device/*terminal 70* has advertising copy. A corporate logo reads on advertising copy. Because it supports product sales and customer service to identify a product with a product logo, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Tracy et al. that the back/second side of said data collection device/*terminal 70* has the manufacturer's logo/advertising copy.

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6. Tracy et al. does not teach that said demographic data is linked to said unique identifier/unique IP address. Because it would be useful for marketing and operational purposes to know which customers used which data collection device/*terminal 70*, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Tracy et al. that said *customer loyalty card 210*/demographic data be linked to said unique identifier/*unique IP address*.
7. For claim 16, different pieces of software read on "said first portion" and "said second portion". Tracy et al. does not teach that said at least one coupon (col. 11 line 5) is linked to said unique identifier/unique IP address. It would have been obvious to do so for the reason given in para. 6 above. Tracy et al. does teach pinpoint marketing and coupon tracking (col. 12 lines 50-53), which reads on the remainder of claim 16.
8. Tracy et al. also teaches claim 10 (col. 6 line 16), and claims 18 and 20 at the citations given above.
9. Tracy et al. does not teach (claims 17 and 19) marketing to minimize cost. Because maximization of profit entails controlling cost, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Tracy et al. that the marketing program be conducted so as to minimize cost.

Suggestion of Allowable Subject Matter

10. The specification (Fig. 1 and p. 3 line 14 to col. 4 line 21) discloses an essentially two-dimensional, non-electrical, data collection device with coupons printed thereon. Properly claiming this limitation would overcome the present rejection. The examiner will accept "an essentially two-dimensional, non-electrical, data collection device" as a claim limitation that describes the Fig. 1 feature without introducing new matter.
11. Applicant is cautioned that an allowance could not be considered until this or any other amendment was searched.

Conclusion

12. The references made of record and not relied upon are considered pertinent to applicant's disclosure. Battin et al. (US 20030055724A1), which is not prior art, teaches some aspects of the instant invention.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717. The examiner's supervisor, Anthony Knight, can be reached on 571-272-3687.
14. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 2121

24 October 2004


